

IPED

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

WRITTEN OPINION (PCT Rule 66)

To:

FERRARO, Neil, P.
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210
ETATS-UNIS D'AMERIQUE

Date of mailing
(day/month/year) 19.07.2004

Applicant's or agent's file reference
L0532.70032 *hoo*

REPLY DUE within 3 month(s)
from the above date of mailing

International application No.
PCT/US 03/1876

International filing date (day/month/year)
08.10.2003

Priority date (day/month/year)
08.10.2002

International Patent Classification (IPC) or both national classification and IPC
B42D15/00

Confirmation	initials
Docketing	<input type="checkbox"/> <i>hoo</i> <input checked="" type="checkbox"/> <i>hoo</i>
<i>9/19/04</i> <i>13/19/04</i> <i>2/8/05 - hoo</i>	

Applicant
VERIFICATION TECHNOLOGIES, INC. et Al.

1. This written opinion is the **first** drawn up by this International Preliminary Examining Authority.
2. This opinion contains indications relating to the following items:
 - I ☒ Basis of the opinion
 - II ☐ Priority
 - III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
 - IV ☐ Lack of unity of invention
 - V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
 - VI ☐ Certain documents cited
 - VII ☐ Certain defects in the international application
 - VIII ☐ Certain observations on the international application

NPF

3. The applicant is hereby **invited to reply** to this opinion.

When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also: For an additional opportunity to submit amendments, see Rule 66.4.
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis.
For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.

4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: 08.02.2005 ✓

Name and mailing address of the international preliminary examining authority:

European Patent Office - P.B. 5818 Patentlaan 2
NL-2280 HV Rijswijk - Pays Bas
Tel. +31 70 340 - 2040 Tx: 31 651 epo nl
Fax: +31 70 340 - 3016

Authorized Officer

Evans, A

Formalities officer (incl. extension of time limits)
Rasmussen, S
Telephone No. +31 70 340-4595



I. Basis of the opinion

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed"*):

Description, Pages

1-33 as originally filed

Claims, Numbers

1-37 as originally filed

Drawings, Sheets

1/7-7/7 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
☐ the language of publication of the international application (under Rule 48.3(b)).
☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority in written form.
☐ furnished subsequently to this Authority in computer readable form.
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
☐ the claims, Nos.:
☐ the drawings, sheets:

5. ☐ This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

6. Additional observations, if necessary:

WRITTEN OPINIONInternational application No. PCT/US 03/31876

V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**1. Statement**

Novelty (N)	Claims	1,2,5-7,9,10,12,14,16-37
Inventive step (IS)	Claims	8,11,13,15
Industrial applicability (IA)	Claims	

2. Citations and explanations**see separate sheet**

Re Section V

Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Reference is made to the following documents:

D1: WO0054985

2. Document D1 shows (page 8 line 1 - page 9, line 4):

- a. An authentication mark (11) applied to a substrate(10) for aiding in the determination of whether the substrate is authentic, comprising a first image (20) comprising a first compound (17), the first compound (17) adapted to be altered between at least a first state and a second state, wherein a change from the first state to the second state suggests that the substrate(10) is authentic, cf claim 1.
- b. A method of authenticating a substrate (19) having an authentication mark (11) on the substrate (10), wherein a consumer can perform at least a portion of an authentication, the mark (11) comprising a first image (20), wherein a first compound (17) is used to create at least a portion of the first image (20), the first compound (17) adapted to be altered between at least a first state and a second state, the method comprising: viewing the first image (20) when the first compound (17) is in the first state; changing the first compound (17) from the first state to the second state; viewing the first image (20) when the first compound (17) is in the second state; and determining whether the mark (11) is authentic based on a change between the first and second states, cf claim 31.

Therefore the subject-matter of claims 1 and 31 is not new, Article 33(2) PCT..

- 3.1 The additional features of dependent claims 2,5-7,9,10,12,14,16-30,32-37 are implicit in document D1 considering that D1 discloses a security element comprising fluorescent and thermochromic parts- both of which can change from first to second states. The thermochromic part being readily tested by a consumer while the fluorescent part is invisible to the naked eye.

**WRITTEN OPINION
SEPARATE SHEET**

International application No. PCT/US03/31876

- 3.2 Dependent claims 8,11,13 and 15 do not appear to contain any additional features which involve an inventive step when combined with the subject matter of any claim to which they refer.
4. The combination of the features of dependent claims 3 or 4 is neither known from, nor rendered obvious by, the available prior art. It is suggested therefore that a new independent claim be drafted to include these features.
5. The applicant is requested to file amendments by way of replacement pages in the manner stipulated by Rule 66.8(a) PCT. In particular, fair copies of the amendments should be filed preferably in triplicate.

In order to facilitate the examination of the conformity of the amended application with the requirements of Article 34(2)(b) PCT, the applicant is requested to clearly identify the amendments carried out, no matter whether they concern amendments by addition, replacement or deletion, and to indicate the passages of the application as filed on which these amendments are based (see also Rule 66.8(a) PCT).

+++++